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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,623	11/30/2000	Ron Cohen	50325-0503	5418
29989	7590	05/27/2005	EXAMINER	
HICKMAN PALERMO TRUONG & BECKER, LLP			JUNTIMA, NITTAYA	
2055 GATEWAY PLACE				
SUITE 550			ART UNIT	PAPER NUMBER
SAN JOSE, CA 95110			2663	

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/729,623

Applicant(s)

COHEN ET AL.

Examiner

Nittaya Juntima

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26-29 is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/12/04, 1/4/05.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. This action is in response to the RCE filed 10/12/2004.
2. The indicated allowability of claims 1-26 is withdrawn in view of the newly discovered reference(s) to Mohaban et al. (USPN 6,788,647 B1). Rejections based on the newly cited reference(s) follow.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,788,647 B1.

Regarding claim 1, although the conflicting claims are not identical, they are not patentably distinct from each other because (i) claim 1 of the instant application contains broader version of the limitations recited in claim 2 of the patent, e.g. the steps of receiving, creating and, receiving the return packet flow and determining the association with the originating packet flow, and marking return packet flow of the instant application correspond to the steps of

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receiving, creating and storing, receiving one more inbound message elements and determining the association with the bidirectional network data flow, and marking the inbound message elements with the DSCP value as recited in claim 2 of the patent, and (ii) claim 2 of the patent does not include the step of “determining that one or more packets in the originating packet flow are marked with a DSCP value that matches a policy rule that requires setting a specified DSCP value in the return packet flow” as recited in claim 1 of the instant application. However, the patent discloses that policy information (a policy rule) may be installed to identify a DSCP value of the opposite flow (the return packet flow), col. 8, ll 32-37. Therefore, it would have been obvious to a designer of ordinary skill in the art to modify the teaching of the patent to include the determining step as recited in the instant application. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

Regarding claims 2-3, 6, these claims contain limitations, e.g. a flow table, a network-based application recognition table, and a static policy at a policy server, which would have been obvious to one skilled in the art over claim 4 of the patent.

Regarding claim 4, the limitation “identifying an end of the originating packet flow and removing the stored information that identifies the originating packet flow and a second DSCP value for marking the return packet flow” would have been obvious to a designer of ordinary skill in the art.

Regarding claim 5, this claim contains the limitation as claim 12 of the patent.

Claims 7-12 are computer-readable medium carrying instructions claims corresponding to method claims 1-3, 5-6, and 4 respectively, are rejected under the same reason set forth in the rejections of claims 1-3, 5-6, and 4, respectively.

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Claims 13-15, and 17-19 are apparatus claims corresponding to method claims 1-3-5, 6, and 4, respectively, and are rejected under the same reason set forth in the rejections of claims 1-3, 5, 6, and 4, respectively.

Regarding claim 16, the claim contains the limitation “the first DSCP includes a request for application of the same quality of service treatment to the return packet flow has a value that is one unit greater than the second DSCP value” which would have been obvious to a designer of ordinary skill in the art as long as the first and second DSCP values provide the same QoS treatment and it does not produce any unexpected results.

Claims 20-25 are apparatus claims corresponding to method claims 1-3-5, 6, and 4, respectively, and are rejected under the same reason set forth in the rejections of claims 1-3, 5, 6, and 4, respectively.

Allowable Subject Matter

5. Claims 26-29 are allowed. The cited prior arts alone or in combination fail to teach or make obvious on the following: creating and storing a first DSCP value and a second DSCP value that are both associated with the same PHB treatment but are each associated with a different reflective DSCP setting, marking the packet of the return flow with the second DSCP value if the received packet(s) in the originating packet flow are marked with the first DSCP value, otherwise marking the packet(s) of the return flow with the second DSCP value.

Conclusion

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nittaya Juntima whose telephone number is 571-272-3120. The examiner can normally be reached on Monday through Friday, 8:00 A.M - 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Ngo can be reached on 571-272-3139. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nittaya Juntima
May 20, 2005

NJ


RICKY NGO
PRIMARY EXAMINER

5/20/05